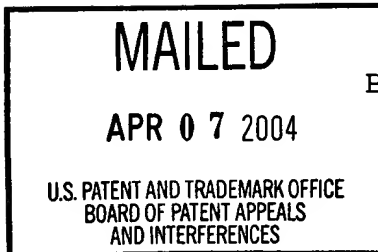


UNITED STATES PATENT AND TRADEMARK OFFICE



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
\_\_\_\_\_

Ex parte PHILLIP JOHN BLACK  
\_\_\_\_\_

Application No. 09/842,028  
\_\_\_\_\_

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER  
\_\_\_\_\_

This application was received at the Board of Patent Appeals and Interferences on March 8, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

On June 17, 2003, an Examiner's Answer was mailed (Paper No. 11). A review of the Examiner's Answer reveals that there is no evidence that an appeals conference was conducted by the examiner. According to the Manual of Patent Examining Procedure (MPEP) § 1208 (8th ed., Rev. 1, February 2003):

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. This will make the record clear that an appeal conference has been held.

In addition, on August 18, 2003, appellant filed a Reply Brief (Paper No. 12). The examiner' responded to appellant's Reply Brief in a communication mailed on August 28, 2003. According to the Manual of Patent Examining Procedure (MPEP) § 1208.03:

Under 37 CFR § 1.193(b)(1), appellant may file a reply brief as a matter of right within 2 months from the mailing date of the examiner's answer or supplemental examiner's answer. . . . The primary examiner must then either: (A) acknowledge receipt and entry of the reply brief by using form paragraph 12.47 on form PTOL-90; or (B) reopen prosecution to respond to the reply brief. See MPEP § 1208.02. A supplemental examiner's answer is not permitted unless the application has been remanded by the Board for such purpose.

MPEP § 1208.03 further states:

While 37 CFR § 1.193(b)(1) prohibits a supplemental examiner's answer (in the absence of a remand from the Board of Patent Appeals and Interference[s] for such purpose), an examiner may (with supervisory patent examiner approval) respond to a reply brief by reopening prosecution. The acknowledgment of receipt and entry of a reply brief under 37 CFR § 1.193(b)(1) is an indication by the examiner that no further response by the examiner is deemed necessary.

A review of the application reveals that the examiner has not properly responded to appellant's Reply Brief filed on August 18, 2003 (Paper No. 12).

Accordingly, it is

ORDERED that the application is returned to the examiner for resolution of the following issues:

(1) to take corrective action with respect to the appeals conference,

Application No. 09/842,028

(2) to properly respond to appellant's Reply Brief filed on August 18, 2003 (Paper No. 12),

(3) and for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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FCH/clm/dm  
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